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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/301,906	04/29/99	GONSALVES	07678/077002

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EXAMINER

BUI, P

ART UNIT	PAPER NUMBER
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1645

DATE MAILED: 06/15/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/301,906

Applicant(s)
Gonsalves et al.

Examiner
Phuong Bui

Group Art Unit
1645



☒ Responsive to communication(s) filed on Oct 7, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-34 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-34 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-4, drawn to a proteinase, classified in class 435, subclass 219.
 - II. Claims 1-3 and 5, drawn to a methyltransferase, classified in class 435, subclass 193.
 - III. Claims 1-3, drawn to a helicase, classified in class 435, subclass 183.
 - IV. Claim 1, drawn to SEQ ID NO:11 (orf 1b), classified in class 530, subclass 350.
 - V. Claim 1, drawn to SEQ ID NO:13 (orf 11), classified in class 530, subclass 300.
 - VI. Claims 6-12, 19, 20, and 22-31, drawn to a nucleic acid encoding proteinase, classified in class 536, subclass 23.2.
 - VII. Claims 6-10, 13, 14, 19, 20, and 22-31, drawn to a nucleic acid encoding methyltransferase, classified in class 536, subclass 23.2.
 - VIII. Claims 6-10, 15, 16, 19, 20, and 22-31, drawn to a nucleic acid encoding helicase, classified in class 536, subclass 23.2.
 - IX. Claims 6, 7, 17, 19, 20, and 22-31, drawn to a nucleic acid encoding SEQ ID NO:11, classified in class 536, subclass 23.72.
 - X. Claims 6, 7, 18-20, and 22-31, drawn to a nucleic acid encoding SEQ ID NO:13, classified in class 536, subclass 23.72.

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- XI. Claims 7, 19, 20, and 22-31, drawn to nucleic acid SEQ ID NO:2 (5' untranslated region), classified in class 536, subclass 24.1.
- XII. Claims 7, 19, 20, and 22-31, drawn to nucleic acid SEQ ID NO:14 (3' untranslated region), classified in class 536, subclass 24.1.
- XIII. Claims 7, 19, and 21, drawn to an antisense nucleic acid of proteinase, classified in class 536, subclass 24.5.
- XIV. Claims 7, 19, and 21, drawn to an antisense nucleic acid of methyltransferase, classified in class 536, subclass 24.5.
- XV. Claims 7, 19, and 21, drawn to an antisense nucleic acid of helicase, classified in class 536, subclass 24.5.
- XVI. Claims 7, 19, and 21, drawn to an antisense nucleic acid of SEQ ID NO:11 polypeptide, classified in class 536, subclass 24.5.
- XVII. Claims 7, 19, and 21, drawn to an antisense nucleic acid of SEQ ID NO:13 polypeptide, classified in class 536, subclass 24.5.
- XVIII. Claims 7, 19, and 21, drawn to an antisense nucleic acid of SEQ ID NO:2, classified in class 536, subclass 24.5.
- XIX. Claims 7, 19, and 21, drawn to an antisense nucleic acid of SEQ ID NO:14, classified in class 536, subclass 24.5.
- XX. Claim 32, drawn to an antibody of proteinase, classified in class 530, subclass 388.26.

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- XXI. Claim 32, drawn to an antibody of methyltransferase, classified in class 530, subclass 388.26.
- XXII. Claim 32, drawn to an antibody of helicase, classified in class 530, subclass 388.26.
- XXIII. Claim 32, drawn to an antibody of SEQ ID NO:11, classified in class 530, subclass 387.9.
- XXIV. Claim 32, drawn to an antibody of SEQ ID NO:13, classified in class 530, subclass 387.9.
- XXV. Claim 33, drawn to a method of detection using proteinase antibody, classified in class 435, subclass 23.
- XXVI. Claim 33, drawn to a method of detection using methyltransferase antibody, classified in class 435, subclass 15.
- XXVII. Claim 33, drawn to a method of detection using helicase antibody, classified in class 435, subclass 7.4.
- XXVIII. Claim 33, drawn to a method of detection using antibody to SEQ ID NO:11, classified in class 435, subclass 7.1.
- XXIX. Claim 33, drawn to a method of detection using antibody to SEQ ID NO:13, classified in class 435, subclass 7.1.
- XXX. Claim 34, drawn to a method of detection using proteinase nucleic acid, classified in class 435, subclass 6.

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XXXI. Claim 34, drawn to a method of detection using methyltransferase nucleic acid, classified in class 435, subclass 6.

XXXII. Claim 34, drawn to a method of detection using helicase nucleic acid, classified in class 435, subclass 6.

XXXIII. Claim 34, drawn to a method of detection using SEQ ID NO:11 nucleic acid, classified in class 435, subclass 6.

XXXIV. Claim 34, drawn to a method of detection using SEQ ID NO:13 nucleic acid, classified in class 435, subclass 6.

XXXV. Claim 34, drawn to a method of detection using SEQ ID NO:2 nucleic acid, classified in class 435, subclass 6.

XXXVI. Claim 34, drawn to a method of detection using SEQ ID NO:14 nucleic acid, classified in class 435, subclass 6.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I-XXIV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different effects. The proteins/polypeptides group of Inventions I-V, the nucleic acids group of Inventions VI-XII, the antisense molecules group of Inventions XIII-XIX, and the antibodies group of Inventions XX-XXIV are chemically, structurally, biologically, and

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immunologically distinct from each other, within each group of inventions as well as among the different groups of inventions.

3. Inventions XXV-XXIX are unrelated. In the instant case the different inventions are not disclosed as capable of use together and they have different modes of operation. Each of the inventions uses a different antibody which binds to different epitopes of different proteins.
4. Inventions XXX-XXXVI are unrelated. In the instant case the different inventions are not disclosed as capable of use together and they have different modes of operation. Each of the inventions uses a different nucleic acid molecule which hybridizes a different region of the virus genome.
5. Inventions XX-XXIV (antibodies) and XXV-XXIX (methods of detection) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using that product. The antibodies of Inventions XX-XXIV can be used to generate antiidiotypic antibodies in an administered animal.
6. Inventions VI-XII (nucleic acids) and XXX-XXXVI (methods of detection) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially

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different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using that product. The nucleic acids can also be used for recombinant protein expressions.

7. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, searches, and recognized divergent subject matter, restriction for examination purposes as indicated is proper.

8. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

10. Papers relating to this application may be submitted to Technology Sector 1 by facsimile transmission. Papers should be faxed to Crystal Mall 1, Art Unit 1645, using fax number (703) 308-4242. All Technology Sector 1 fax machines are available to receive transmissions 24 hrs/day, 7 days/wk. Please note that the faxing of such papers must conform with the Notice published in the Official Gazette, 1096 OG 30, (November 15, 1989).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuong Bui whose telephone number is (703) 305-1996. The Examiner can normally be reached Monday-Friday from 6:30 AM - 4:00 PM.

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If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Anthony Caputa, can be reached at (703) 308-3995.

Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is (703) 308-0196.

Phuong Bui
Primary Examiner
Group Art Unit 1645
June 14, 2000

P Bui
PHUONG T. BUI
PATENT EXAMINER